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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,057	04/27/2001	Anthony S. Volpe	VAK-PT005.1	2706
3624	7590	07/05/2006	EXAMINER	
VOLPE AND KOENIG, P.C. UNITED PLAZA, SUITE 1600 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103			FLANDERS, ANDREW C	
			ART UNIT	PAPER NUMBER
			2615	

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,057

Applicant(s)

VOLPE ET AL.

Examiner

Andrew C. Flanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11, 13-19, 21, 22 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-11, 13-19, 21, 22 and 24-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Applicant's arguments filed 09 March 2006 have been fully considered but they are not persuasive.

Applicant alleges:

"The September 19, 2005 Office Action acknowledges that Gorbet does not disclose the use of "client related materials." Therefore, Gorbet cannot anticipate amended claims 25-28. Schering Corp., 339 F.3d at 1379."

The Examiner disagrees. During the initial review of Gorbet, it was determined that the use of client related materials" was not present in the reference. However, upon re-review of the reference, the Examiner has determined that this element is in fact present in the Gorbet reference as is shown in the rejection.

Furthermore the language in the claims does not recite "client related materials". The exact language in claim 25 is "client selected, event related materials" as currently presented. Thus, the materials are not client related but event related and merely selected by the client. Claims 26 – 28 include the same limitation.

Applicant alleges in regards to the rejections of claims 10, 13 and 14:

"In rejecting claims 10, 13 and 14, the Action found that Gorbet does not disclose "guest information" but that this feature is "well known" or in the case of claim 14 "inherent". The Action attempts to support this assertion with cites from pages from the website www.wikipedia.com ("wikipedia") that were attached to the Action. Since it is unclear whether claims 10, 13 and 14 are being rejected as obvious by the combination of Gorbet and wikipedia (see rejection of claim 19 on page 15) or by Gorbet only. This is necessary and the natural consequence of the Action

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because there is no evidence in the record indicating that wikipedia is prior art to the present application. MPEP (706.02(j)) "It, is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair-opportunity to reply MPEP 706.02(a); MPEP 707.05(e).

Examiner disagrees. Claims 10, 13, 14 and 19 were rejected as being unpatentable over Gorbet. The wikipedia citation was included as evidence merely to show Applicant details about slide show presentations that are disclosed in Gorbet. Since it is not used in a combination of the reference it is not necessary to provide a date. However, it should be noted that PowerPoint was released in 1987 which is clearly stated in the first page of the wikipedia.com document. Additionally, Gorbet discusses in the Background of the invention the various uses of Microsoft Power thus, from this disclosure, the program was being used at least at the time of filing of Gorbet.

Applicant further alleges in regards to claims 10, 13 and 14:

"The one section of wikipedia regarding the operation of PowerPoint does not discuss the content of a presentation or individual slides being "geared toward" the audience. Wikipedia includes one reference to PowerPoint being widely used by educators," but it is devoid of any reference to the example provided by the Examiner of an English professor creating or presenting a presentation for students relating to Shakespeare."

Referring back to the wikipedia.com document, the very first paragraph states that the program is widely used by business people, educators, and trainers. As this program is used by these types of persons, it is obvious that they would target an audience. Educators, for example, include information targeted toward their students.

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This is obvious feature and selling point of the power point software suite. The software can be used to provide any type of slide in any type of manner. Educators would want to include information pertinent to their students in order to educate them. It is obvious that a math educator would include math slides for a math student, an English educator would provide English related slides for an English student etc... These are the features of the slide show program. The fact that these are targeted towards an audience must require some information about that audience, i.e. guest information. As such the argument is not persuasive.

Regarding the arguments as to claim 19,

The rejection included the RWM reference, however, this is a typographical error that was carried over from the previous rejection. As to evidence of the official notice, Ianna (U.S. Patent 5,161,250) discloses receiving a security deposit to ensure the return of goods; col. 1 lines 10 – 16.

The arguments regarding claims 4, 18 and 24 are not persuasive for the reasons stated above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2, 3, 5 – 9, 11, 15 – 17, 21, 22, 25, 26, 27 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Gorbet (U.S. Patent 6,072,480).

Regarding **Claim 25**, Gorbet discloses:

A virtual DJ (i.e. mechanism for playing custom music soundtracks to accompany an electronic slide show; col. 3 lines 66 – 67 and col. 43 line 1) comprising:

a recording media for recording a performance to be played at a future event (i.e. the slide presentation is generally stored on a computer medium; col. 5 lines 62 – 65 and the computer includes a CD drive for writing; col. 4 lines 54 – 670);

a collection of client selected, event related materials (i.e. the author (*client*) selects and edits slides; col. 5 lines 60 – 63; and the slide show may have motifs (*event specific material*), which are short music solos played whenever a predetermined event occurs; col. 9 lines 40 – 42; (although not explicitly relied upon for this rejection, it is noted that the event specific materials may be the content of the slide show, for example a corporations quarterly earnings meeting slide show presentation would be programmed with information specific to that meeting)); and

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DJ performance materials arranged with and among client selected, event related materials (i.e. the slide show program includes code for controlling an electronic slide show (*DJ performance materials*); and a sound clip that is embedded in a slide (*event specific comments*); col. 6 lines 18 – 32), musical performances (i.e. playing audio data; col. 6 line 25; the author has selected and edited the slides and added the event specific materials as shown above) such that a DJ like performance related to the future event is fixed on the recording media (i.e. saving the slide show presentation allows the playback of an electronic slide show at a time in the future; col. 6 lines 18 – 32).

Regarding **Claim 26**, Gorbet discloses:

A method for performing recorded material at a future event (i.e. the slide show is recorded onto a CD for future playback; col. 6 lines 18 – 32 and col. 5 lines 62 – 63), the method comprising:

gathering client selected event related materials (i.e. the author (*client*) selects and edits slides; col. 5 lines 60 – 63; and the slide show may have motifs (*event specific material*), which are short music solos played whenever a predetermined event occurs; col. 9 lines 40 – 42; (although not explicitly relied upon for this rejection, it is noted that the event specific materials may be the content of the slide show, for example a corporations quarterly earnings meeting slide show presentation would be programmed with information specific to that meeting));

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producing a recorded DJ like performance related to the future event (i.e. an electronic slide show; col. 6 lines 18 – 32) by arranging a DJ's performance material with and among (i.e. the slide show program includes code for controlling an electronic slide show (*DJ performance materials*); and a sound clip that is embedded in a slide (*event specific comments*); col. 6 lines 18 – 32) (i.e. playing audio data; col. 6 line 25) client selected, event related materials(the author has selected and edited the slides and added the event specific materials as shown above);

storing the recorded DJ like performance on media (i.e. stored on a computer storage medium; col. 5 lines 62 – 63 such as a CD-ROM col. 4 lines 55 – 60); and

playing the recorded performance at the future event (i.e. the saved performance may be played back at any time or event in the future).

Regarding **Claim 27**, Claim 27 is rejected under the same grounds as claim 26 above.

Regarding **Claim 28**, Gorbet discloses:

A media for broadcast at a future event (i.e. a slide presentation stored on a computer storage medium; col. 5 lines 62 – 63 such as a CD-ROM col. 4 lines 55 – 60), material fixed on the media comprises:

a selection of client selected, event related materials (i.e. the author (*client*) selects and edits slides; col. 5 lines 60 – 63; and the slide show may have motif's (*event specific material*), which are short music solos played whenever a predetermined event

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occurs; col. 9 lines 40 – 42; (although not explicitly relied upon for this rejection, it is noted that the event specific materials may be the content of the slide show, for example a corporations quarterly earnings meeting slide show presentation would be programmed with information specific to that meeting)); and

DJ performance materials arranged with and among (i.e. the slide show program includes code for controlling an electronic slide show (*DJ performance materials*); and a sound clip that is embedded in a slide (*event specific comments*); col. 6 lines 18 – 32), musical performances (i.e. playing audio data; col. 6 line 25) selected event related materials (the author has selected and edited the slides and added the event specific materials as shown above) such that a DJ like performance related to the future event is fixed on the recording media (i.e. saving the slide show presentation allows the playback of an electronic slide show at a time in the future; col. 6 lines 18 – 32).

Regarding **Claim 2**, in addition to the elements stated above regarding claim 25, Gorbet further discloses:

wherein the media is an audio media (i.e. the media is a CD-ROM which includes a slide show with audio on it).

Regarding **Claim 3**, in addition to the elements stated above regarding claim 25, Gorbet further discloses:

wherein the media is audio and visual (i.e. the slide show displays a slide and plays audio data; col. 6 lines 18 - 32).

Regarding **Claim 5**, in addition to the elements stated above regarding claim 25, Gorbet further discloses:

wherein the media is a compact disc (i.e. a CD-ROM; col. 4 lines 55 – 60).

Regarding **Claim 6**, in addition to the elements stated above regarding claim 25, Gorbet further discloses:

wherein the media is a compact disc read only memory (i.e. a CD-ROM; col. 4 lines 55 – 60).

Regarding **Claim 7**, in addition to the elements stated above regarding claim 3, Gorbet further discloses:

wherein the media includes pictures for display at the future event (i.e. the slide show col. 4 lines 5 – 10).

Regarding **Claim 8**, in addition to the elements stated above regarding claim 3, Gorbet further discloses:

wherein the media includes a slide show for display at the future event (i.e. the slide show col. 4 lines 5 – 10).

Regarding **Claim 9**, in addition to the elements stated above regarding claim 25, Gorbet further discloses:

wherein the media includes songs from a play list (i.e. the user selects one of three custom soundtrack options; col. 8 lines 15 – 20).

Regarding **Claim 11**, in addition to the elements stated above regarding claim 25, Gorbet further discloses:

wherein the media includes software to enable a display of visual effects synchronized with audio portions of the DJ performance materials (i.e. a slide show presentation; col. 6 lines 18 – 32).

Regarding **Claim 15**, in addition to the elements stated above regarding claim 26, Gorbet further discloses:

where the arrangement of the recorded performance is based in part on an event itinerary (i.e. the slide show is inherently an itinerary for a presentation, the music soundtrack is associated with the slides and thus the arrangement is based upon them; col. 8 lines 15 – 20).

Regarding **Claim 16**, in addition to the elements stated above regarding claim 26, Gorbet further discloses:

an event client providing pertinent information regarding the future event (i.e. the author edits the performance and thus inserts pertinent information for the presentation which is to be viewed at a future event; col. 5 lines 55 – 67 and col. 6 lines 1 – 5).

Regarding **Claim 17**, in addition to the elements stated above regarding claim 26, Gorbet further discloses:

providing an event client the recorded performance in a media (i.e. the slide show is saved on a CD as shown above).

Regarding **Claim 21**, in addition to the elements stated above regarding claim 27, Gorbet further discloses:

wherein the gathering means includes an Internet web site having an input configured to receive client selected event related materials provided by an event client (i.e. means for connecting to the internet; col. 5 line 49; and in a networked environment, program modules depicted relative to the personal computer, or portions thereof, may be stored in the remote memory storage device; col. 5 lines 50 – 53)

Regarding **Claim 22**, in addition to the elements stated above regarding claim 27, Gorbet further discloses:

wherein the playing means includes a computer (Fig. 1)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if

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the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10,13, 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorbet (U.S. Patent 6,072,480).

Regarding **Claim 10**, in addition to the elements stated above regarding claim 25 Gorbet further discloses:

wherein the client selected, event related materials include information (i.e. a slide may also comprise other information; col. 6 lines 4 – 5).

Gorbet doesn't explicitly state that the other information is guest information, however, it is well known that slide show presentations, such as Power Point presentations are geared toward their audience (see the Wikipedia.com document for Power Point), thus the author must inherently have information about the guests. For example, an English professor (an educator as shown in Wikipedia.com) may have a presentation for display to his students related to Shakespeare. Thus, the slide show is geared to the students (*guests*).

Creating a slide show geared towards the viewers is desirable to keep their interest during playback.

Regarding **Claim 13**, in addition to the elements stated above regarding claim 26, Gorbet further discloses:

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wherein the gathering of client selected, event related materials is in response to a play list and information (i.e. the author edits the slides; col. 5 lines 58 – 62; and the author selects one of three custom soundtrack options; col. 8 lines 15 – 20).

Gorbet doesn't explicitly state that the other information is guest information, however, it is well known that slide show presentations, such as Power Point presentations are geared toward their audience (see the Wikipedia.com document for Power Point), thus the author must inherently have information about the guests. For example, an English professor (an educator as shown in Wikipedia.com) may have a presentation for display to his students related to Shakespeare. Thus, the slide show is geared to the students (*guests*).

Creating a slide show geared towards the viewers is desirable to keep their interest during playback.

Regarding **Claim 14**, in addition to the elements stated above regarding claim 13, Gorbet fails to disclose wherein the guest information includes stories and idiosyncrasies.

However, from the example shown in claim 13, the slide presentation of an English professor using the Power Point program would inherently contain stories and idiosyncrasies.

Regarding **Claim 19**, in addition to the elements stated above regarding claim 17, Gorbet fails to disclose accepting a security deposit from the event client prior to the

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step of providing. However, Examiner takes official notice that taking a security deposit prior to providing goods or services is notoriously well known in the art. One would have been motivated to accept a security deposit prior to the step of providing in order to ensure the items given out were returned in a usable condition as evidenced by (Ianna U.S. 5,161,250)

Claims 4, 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorbet (U.S. Patent 6,072,480) in view of Bakos (U.S. Patent 6,511,728).

Regarding **Claims 4, 18 and 24**, in addition to the elements stated above regarding claims 25, 17 and 28, Gorbet doesn't disclose wherein the media has a predetermined life span.

Bakos discloses an optical media that can only be used for a limited period of time; col. 2 lines 63 – 67.

It would have been obvious to one of ordinary skill in the art at the time of the invention to record the slide show onto a CD with a limited life as disclosed by Bakos. One would have been motivated to do so in a situation where the slide show on the CD was a demo; see Bakos lines 45 – 50.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C. Flanders whose telephone number is (571) 272-7516. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7546. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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SUPERVISORY PATENT EXAMINER